

Appl. No. 10/695,631
Amdt. dated June 28, 2005
Reply to Office Action of February 28, 2005

PATENT

Amendments to the Drawings:

The attached sheets of drawings include corrected Figures 1-8. The corrected drawings replace the original sheets.

Redlined copies of the original drawings, as filed, are provided to identify the corrections to the drawings.

Attachment: Replacement Sheets
Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Claims 1-6, 12-13, and 21-33 are pending in the application. Applicant, by this paper, amends claims 1 and 24, cancels claims 7-11 without prejudice, and adds new claims 25-33. Applicant respectfully requests reconsideration of the previously examined claims and allowance of all pending claims.

Discussion of Objections to the Drawings

Applicant submits a set of redlined drawings and corrected drawings accompanying this response. In particular, the drawings have been corrected to delete words identifying structure on the drawings and to ensure that lead lines are associated with a single figure. Additionally, the drawings have been corrected to distinctly identify the section lines appearing in the various figures. No new matter has been added to the figures.

Applicant respectfully believes that the reference numerals "113" and "118" correctly identify the structure described in the specification. Reference numeral "113" corresponds to a "throat portion" and reference numeral "118" corresponds to a "throat area" having an increased thickness. These portions of the punch assembly are discussed at page 9 ll. 3-14 of the specification, as filed. Therefore, the Applicant has made no change to these reference numerals.

Discussion of Objections to the Specification

Applicant has amended several paragraphs in the Specification to overcome the objections identified by the Examiner and to align the reference numerals identified in the text with the reference numerals appearing in the figures.

In particular, several paragraphs appearing under the heading "Brief Description of the Drawings" have been amended to coincide with the reference numerals used to identify the section views.

The paragraph appearing at page 5 lines 17-21 has been amended in the manner suggested by the Examiner. The paragraph appearing at page 9 lines 12-14 has been amended to make language accompanying reference numeral "113" consistent throughout the specification.

Applicant respectfully disagrees that the term “bear” appearing at page 3, line 2 should be changed to --bare--. The term “bear” is defined to mean “to relate; to have as a visible characteristic, to have as a quality.” *Webster’s II New College Dictionary* 96 (2001). Synonyms include exhibit, maintain, and possess.

The portion of the objected to text reads “like elements bear like reference numerals.” Applicant respectfully believes this to be the correct usage of the word “bear” because the “like elements” have as a visible characteristic or have as a quality the “like reference numerals.” Therefore, Applicant has not amended this paragraph in the manner suggested by the Examiner.

Discussion of Claim Rejections Under 35 U.S.C. §112

Claim 11 was rejected under 35 U.S.C. §112, first paragraph. Applicant, by this paper cancels claim 11 without prejudice. Thus, the rejection to claim 11 is moot in light of the canceled claim.

Discussion of Claim Rejections Under 35 U.S.C. §102

Claims 1-2 and 7-12 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 799,928 to Nehr (hereinafter Nehr). Claim 24 was rejected as allegedly anticipated by U.S. Patent No. 6,189,220 to Chen (hereinafter Chen). Applicant cancels claims 7-11, rendering the rejections of those claims moot.

In order for a claim to be anticipated by a reference, each and every element as set forth in the claim, must be described, either expressly or inherently, in the single prior art reference.

Claim 1, as amended, includes the feature “the handle component configured to maintain an approximate orientation of the cutting component relative to a cutting medium.” Support for Applicant’s amendment can be found, for example, at Figure 9 and the accompanying description at page 6, line 11 through page 7, line 9.

This feature is not described in Nehr. In Nehr, the handle 11 extends upward from the cutting implement. The handle does not maintain an approximate orientation of the cutting component. There is no structure in Nehr that maintains an approximate orientation of

the cutting component relative to a cutting medium. Therefore, Applicant respectfully requests reconsideration and allowance of claim 1, because Nehr fails to describe each and every element as set forth in the claim.

Claims 2 and 12 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Therefore, Applicant respectfully requests reconsideration and allowance of claims 2 and 12.

Claim 24 includes the same feature discussed above in relation to claim 1. Chen fails to discuss such a feature. In Chen, the handle 34 has no relation to the orientation of the cutting component. Instead, the barrel 14 and associated shaft 15 maintain the orientation of the mold piece 40. Thus, Chen fails to describe each and every claim element. Applicant respectfully requests reconsideration and allowance of claim 24.

Discussion of Claim Rejections Under 35 U.S.C. §103

Claims 3-6 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Nehr in view of U.S. Patent No. 3,250,163 to Smith (hereinafter Smith).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Claims 3-6 depend from claim 1. As described above, Nehr fails to describe each and every element of claim 1. Smith fails to describe those elements of claim 1 that are absent from Nehr. Because Smith described a rule die with a powdered metal body and does not describe any handle for a punch, Smith does not discuss any features of a handle component. Thus, because Nehr and Smith, either alone or in combination, fail to teach each and every element of claim 1, the combination of Nehr with Smith also fails to teach each and every element of any claim depending from claim 1. Thus, Applicant respectfully requests reconsideration and allowance of claims 3-6.

Claims 13 and 21 were rejected as allegedly unpatentable over Nehr in view of U.S. patent No. 4,388,743 to Hellinger et al. (hereinafter Hellinger).. The rejection to claim 21 detailed in paragraph 15 of the Office Action mentions a McNabb reference. However, because neither the Applicant's IDS form PTO/SB/08A initialed by the Examiner nor the PTO-892 provided by the Examiner in the present Office Action lists a McNabb reference, Applicant believes that the Examiner intended to refer to Hellinger and the citation to McNabb was inadvertent.

Claim 13 depends from claim 1. As noted earlier, Nehr fails to disclose every element of claim 1. Because Hellinger is directed to a lid handle cover, Hellinger fails to disclose those portions of claim 1 that are absent from the teachings of Nehr. Thus, Nehr and Hellinger, either alone or in combination, fail to teach each and every element of claim 1. The combination of Nehr with Hellinger also fails to teach each and every element of any claim depending from claim 1. Thus, Applicant respectfully requests reconsideration and allowance of claim 13.

Claim 21 includes the feature that "the handle end includes a sleeve with the thickness of the sleeve being approximately equal to one-half of the distance that the punch die extends from the cutting side of the punch holding end."

The Examiner concedes that Nehr fails to disclose a sleeve, but alleges that Hellinger discloses a sleeve that "is relatively thin and, if used with the Nehr device, appears to be half the distance the punch die extends from the cutting side of the punch." *Office Action* dated 2/28/05, page 8, ll. 1-2.

There is no discussion of the thickness of the heat insulating cover 23 of Hellinger. There is also no discussion of the distance that the ring cutter B of Nehr extends from the body 10. Therefore, there is no support in either reference for the Examiner's conclusion that the heat insulating cover of Hellinger would have a thickness that is "approximately equal to one-half of the distance that the punch die extends from the cutting side of the punch holding end."

Furthermore, there is no motivation to combine the teachings of Nehr with Hellinger in a manner that would result in the claimed invention. Even if there is motivation to

combine a heat insulating cover with a cutting implement, there is not motivation to modify the combination in such a manner that “the handle end includes a sleeve with the thickness of the sleeve being approximately equal to one-half of the distance that the punch die extends from the cutting side of the punch holding end.”

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggest the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Even if the teachings of Nehr and Hellinger are combined, there is no motivation to configure the heat insulating cover to have the claimed thickness. An examination of the handle of Nehr shows that there is no relationship between the handle and the distance that the ring cutter B extends from the body 10.

Therefore, the combination of references fails to disclose every claimed feature and there is no motivation to combine or otherwise modify the references in a manner that would result in Applicant’s claimed invention. Therefore, Applicant respectfully requests reconsideration and allowance of claim 21.

U.S. Patent No. 5,561,903 to Bourbeau and Smith do not teach or suggest the feature of claim 21 that is absent from Nehr and Hellinger. Therefore, Applicant respectfully request reconsideration and allowance of claims 22 and 23 at least for the reasons that they depend from allowable base claim 21.

Discussion of New Claims

Applicant adds new claims 25-33. Support for the new claims can be found throughout the Specification, as filed. No new matter is added by the new claims.

In particular, support for claims 25-27 and 31-32 can be found at page 5, ll. 3-7 and page 6, ll. 17-20. Support for claim 28 can be found at page 6, line 7 through page 7, line 2. Support for claim 29 can be found in Figures 1-9 and page 6, line 7 through page 7, line 2. Support for claim 33 can be found at page 7, ll. 2-3.

Applicant believes that the new claims are patentable over the references of record, and respectfully request allowance of all new claims.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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Attachments
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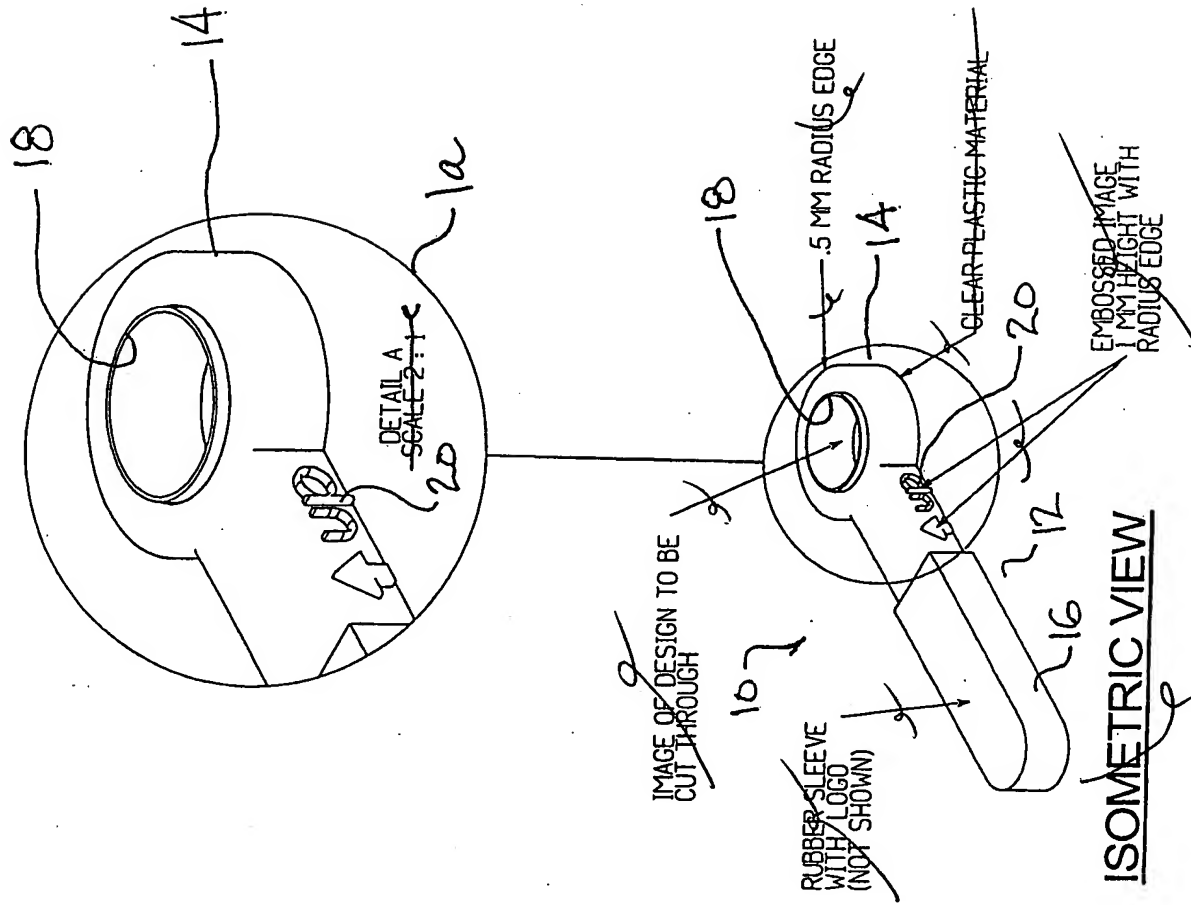


Fig. 1

